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IN THE

Supreme Court of the United States

OCTOBER TERM 1965

No. 1070

NELMOR CORPORATION,
Plaintiff Respondent,

v.

JERVIS CORPORATION
Defendant Petitioner.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

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Petitioner, Jervis Corporation, Defendant and Appellant in the courts below, prays that a Writ of Certiorari issue to review the Judgment herein of the United States Court of Appeals for the Sixth Circuit in so far as the same relates to all of the claims except Claims 2 and 20 of the patent to Jacobson No. 2,931.245.

The Opinion of the Court of Appeals affirming the Opinion and Judgment of the District Court for the Eastern District of Michigan, Southern Division, was released January 7, 1966 and a rehearing, without opinion, was denied on February 3, 1966. The judgment of the Court of Appeals was entered on January 7, 1966.

OPINIONS BELOW

The original Opinion of the United States District Court for the Eastern District of Michigan, Southern Division, was filed on April 27, 1964 and is reported only in the advanced sheets of U.S.P.Q. dated May 18, 1964 at 141 U.S.P.Q. 431 (Page 1 of the advanced sheets is attached to the rear of this Petition). Judgment was entered on April 29, 1964 (R 63a).

On or about May 12, 1964 the District Court altered its Opinion as originally filed by removing page 2 therefrom and substituting a new page 2. The Opinion of the District Court as altered is reported at 229 Fed. Supp. 864, 141 U.S.P.Q. 431 (R 51a). On May 12, 1964 the trial court filed a "Memorandum Supplementing Opinion Filed on April 27, 1964" (R 64a). The Supplemental Opinion is reported at 229 Fed. Supp. 871, 141 U.S.P.Q. 483.

The Opinion of the Court of Appeals for the Sixth Circuit is reported in the advanced sheets, 148 U.S.P.Q. 178 and is included in the certified record and printed in the Appendix.

JURISDICTION

This Court has jurisdiction under 28 U.S.C. Section 1254 (1).

This Petition is filed to have this Court exercise its power of supervision, because the Court of Appeals has sanctioned a departure by the trial court from the accepted and usual course of judicial proceedings.

STATEMENT OF QUESTIONS INVOLVED

1. Should the trial court, in a suit requesting a declaratory judgment of invalidity of a patent having twenty-four claims, have passed judgment on all of the claims when, during the trial, by understanding, acquiescence and agreement between counsel and the court, the issues were limited to and the case was tried on Claims 2 and 20 only, which were the claims alleged to have been infringed?

2. Does the trial court's original opinion, filed in lieu of findings of fact and conclusions of law and specifically directed to Claims 2 and 20 only, support a judgment holding all twenty-four claims of the patent "invalid, void and lacking in invention over the prior art"?

3. Does the trial court's opinion, altered twelve days after the judgment was entered by removing page 2 from the originally filed opinion and inserting a new page therefor to make it superficially appear that the opinion was directed to all of the patent claims, together with the trial court's supplemental opinion filed on February 12, 1964, support the judgment holding all of the patent claims "invalid, void and lacking in invention over the prior art" when no additional findings of fact were made?

STATEMENT OF THE CASE

Plaintiff Respondent filed a complaint requesting a declaratory judgment holding Jacobson Patent No. 2,931,245 for a "Remote Control Device, Particularly for an Automotive Rearview Mirror" invalid and not infringed. Petitioner answered and filed therewith a counterclaim charging infringement of claims 2 and 20 only. Other counterclaims were filed but they are not pertinent to this Petition. By acquiescence, consent and agreement between the parties and the court during the trial, the trial was limited to the issues of validity and infringement of claims 2 and 20 only, those being the claims alleged to have been infringed.

The court filed its opinion on April 27, 1964, in lieu of findings of fact and conclusions of law, and in that opinion expressly limited its decision to Claims 2 and 20 only (see photostat rear of Petition). Although the Court had limited its opinion to Claims 2 and 20 only, in its Judgment filed on April 29, 1964, it held all of the twenty-four claims of the patent in suit invalid.

Petitioner's trial attorney did not receive a copy or have knowledge of the entry of a judgment until approximately fourteen days after it was entered, but in view of the fact that the trial court had limited its opinion to claims 2 and 20 only and had thereafter in the opinion used the term "patent" loosely, without limiting it to the two claims in issue, (R 54a lines 1, 10; R 58a lines 25, 27) corresponded with the court, requesting it to make its Opinion more consistent.

Because of Petitioner's request, the court on or about May 12, 1964 removed page 2 from its original Opinion filed on April 27, 1964 and substituted a new page 2 wherein it was there stated that "the patent here in suit is invalid" (R 52a) in lieu of its original statement that "the patent claims here in suit are invalid" (Rear of Petition). The

Court further altered page 2 of its original opinion which originally read "the patent claims of Jacobson in issue are as follows" followed by the quotation of Claims 2 and 20, by changing the language to read "the patent claims of Jacobson assertedly infringed are as follows" leaving the two claims as quoted. No other change was made, but it now superficially appeared that the opinion was directed to the entire patent.

The U.S.P.Q. evidently obtained a copy of the original opinion, for in its Advance Sheets of May 18, 1964 it reproduced the Opinion of the trial Court as originally filed. A reproduction of page 431 of these advance sheets is inserted in the rear of this Petition for it is not in the record and is found in no other report.

On February 12, 1964 the court also filed a "Memorandum Supplementing Opinion filed on April 27, 1964". This supplemental opinion included no new findings of fact but was simply an argument by the court attempting to justify its Judgment entered on April 29, 1964.

The Court of Appeals on January 7, 1966 affirmed the District Court, stating that a review of the record indicates that the validity of the entire patent and not merely Claims 2 and 20 was in issue. The Court also stated that there was evidence from which the District Judge could and did declare the entire patent invalid. The Court then stated: "We think his findings of fact were adequate and were supported by substantial evidence" (Rear of Petition). The Court then stated:

> "We find nothing improper in the trial Judge making a few changes in his opinion after it was filed, *when minor inaccuracies were called to his attention.*"* (Rear of Petition)

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* Emphasis, wherever found in this petition is Petitioner's.

Petitioner filed a Petition for Rehearing and the same was denied without opinion, on February 3, 1966.

The judgment of the Court of Appeals was entered on January 7, 1966.

ARGUMENT

Petitioner is not contesting the lower courts' decisions holding Claims 2 and 20 of the patent in suit invalid and not infringed. Neither is Petitioner making an issue of the propriety of the trial court's actions in altering the originally filed opinion.

Petitioner is simply requesting this Court to protect petitioner's property rights in the other more limited twenty-two claims which were not considered in the trial of this case nor in the opinion of the court but which were held invalid in the judgment.

THE FIRST QUESTION INVOLVED

> **"1. Should the trial court, in a suit requesting a declaratory judgment of invalidity of a patent having twenty-four claims, have passed judgment on all of the claims when, during the trial, by understanding, acquiescence and agreement between counsel and the court, the issues were limited to and the case was tried on Claims 2 and 20 only which were the claims alleged to have been infringed?"**

Petitioner admits that the original pleadings placed the entire patent in issue and if the issues had not been limited to two claims it would have been the trial court's duty to have passed on all of the claims. However, the courts recognize that even though the pleadings do place all of the claims of a patent in issue, yet by consent and agreement the issues may be limited to a lesser number of claims and the judgment should affect those claims only.

In *United Shoe Machinery Corp. v. Industrial Shoe Machinery,* 335 Fed. 2d 577 (C.A. 1, 1964) that Court had a similar situation as is here. In modifying the trial court's judgment holding all of the patent claims invalid, the Court stated:

> "We hold however that the Court should not have determined invalid claims 1-6. This is not because the Court did not have power to do so under the pleadings, see *Hap Corporation v. Heyman Manf. Co.,* op. ct. *supra* but because Industrial affirmatively told the Court that these claims were not in the case. As to them the judgment should be silent" (p. 581).

The Court of Appeals for the Sixth Circuit has made the same holding several times. Thus in the case of *Goodwin v. Carloss Co. et al.,* 116 F. 2d 644 (1941), that Court stated:

> "The District Court found the entire patent invalid, but, as Claim No. 1 was the only claim in issue, the decree will be modified to the extent that Claim No. 1 only is held invalid, and as so modified is affirmed."

In the case of *Bain v. M. A. Hanna Company,* 331 F. 2d 974, (CA 6, 1964) the trial court, in its judgment, found all of the claims of the patent in suit invalid. The Appeal Court, in modifying that order, stated:

> "Inasmuch as there are twelve claims in the patent which were not litigated (4 to 15), the language of the Court's Order 'that all claims of the patent in suit are invalid,' insofar as it may be construed to apply to claims other than Claims 1, 2 and 3, will be modified so as to be applicable to the three claims in suit only and said Order as so modified is affirmed. This Court has employed such modification procedure on a prior occasion in the patent

case of *Goodwin v. Carloss,* 116 F. 2d 644 (C.A. 6, 1941). See the last paragraph therein."

The Court of Appeals for the Sixth Circuit, on January 5, 1966, rendered its most recent opinion in *Popcorn-In-Oil Council, Inc. v. Wyndall's,* Adv. Shts., 148 U.S.P.Q. 174. The Court cited the *Popcorn case* in its Opinion in the case at bar in an effort to distinguish it, but failed to do so. The only two differences between the Popcorn case and the case at bar are: first, the suit was commenced as an infringement suit and defendant counterclaimed for a declaratory judgment to hold the entire patent invalid, which is just the reverse of the case at bar, and second, the parties in the *Popcorn case* formally stipulated at the beginning of trial to limit the issues to two claims only, rather than during the trial as was done in the case at bar.

In the *Popcorn case* the court held:

> "As we have noted, the District Judge held the Martin patent invalid both because of lack of novelty (anticipation by prior use—35 U.S.C. Sec. 102) and lack of invention (obviousness to others in the art—35 U.S.C. Sec. 103). *Limiting our decision to the two disputed claims* of the Martin patent, we affirm on the second ground cited."
>
> • • • • •
>
> "We therefore agree that claims one and four of the Martin patent (*not the patent as a whole*—see *Felburn v. New York Central Railroad Co.,* 350 F. 2d 416 (C.A. 6, 1965)) are invalid because they do not meet the test of invention and the definition thereof in 35 U.S.C. Sec. 103."

Petitioner asserts that the record in the case at bar discloses that from the very beginning of the trial there was a tacit understanding and acquiescence that only Claims 2 and 20, which were the claims alleged to have been in-

fringed, were in issue and, in at least one instance, this was agreed to by both counsel and the Court. In reviewing the record, this Court should note that Mr. Morriss is Petitioner's attorney while Mr. Kraus is Respondent's attorney.

At record pages 134a-135a Mr. Kraus was discussing some statements made in the Jacobson prosecution file concerning the Hunt prior art patent and comparing it with plaintiff's device.

> "Q. Does the Nelmor unit use springs around the end of the cable and away from the pivot point?
> A. That is our construction.
>
> • • • • •
>
> Mr. Morriss: *Max, is that statement you just read in connection with one of the claims in issue?*
> Mr. Kraus: *Yes. All I am saying is the statement that they made with respect to the Hunt patent,* (115) *regardless of whether it is Claim 2 or 20, you described the Hunt patent, and I read the statement of what you said. I am not saying it has reference to the 20 and 2;* I am saying you said in Hunt the cables had springs, and they were away from the center of the pivot point, and that is all you did and that is all I am stating it for."

At record pages 139a-140a Mr. Kraus was discussing an early model made by Petitioner which used no springs. Counsel for both parties agreed that only claims 2 and 20 were in suit:

> "The Court: I know, but this does not embody all the claims of the patent in suit; it does not involve the claims of the spring tension?
> Mr. Kraus: No, the patent says resilient tension; it does not say 'springs.' *In both claims in suit the words that are used are 'resilient tensioning*

means.' It does not say 'springs.' Therefore, anything that is resilient, even the wire itself is a resilient tensioning means according to their own definition. That is the point I am trying to make. But this comes within the theory of their claim, resilient tensioning means, and therefore, the prior art directly anticipates it, because the prior art shows cables which are resilient tensioning means, but we have this Hunt patent, and the others, which show springs anyway, but we wanted to show how far they were stretching their patent.

The Court: *There is nothing in the claim of the patent in suit that refers to springs?*

Mr. Kraus: None at all, just the words 'resilient tensioning means'; and the word 'resilient', as they apply it (124), could mean a stretched cable in and of itself without a spring. *The word 'spring' is not used in any of the claims in suit.*

The Court: Do you mind if I ask Mr. Morriss if he disagrees with what you have said?

Mr. Morriss: *Your Honor, I agree with what was just said, and I would point out that the claims 2 and 20 in issue go to a combination of elements.*

In other words, I believe that Mr. Kraus is leading the Court to an out-of-context the importance of just tensioning; while just tensioning is the inventive concept, it is an inventive concept embodying other elements.

Now, the other elements are all arranged in that model there substantially in accord with the scope that we claim for claims 2 and 20. In other words, we believe that claims 2 and 20 can be read on that device right before you."

Both Morriss and Kraus were referring to the "claims in issue" or "claims in suit". While the word "patent" is used by the court in the quotation it refers to Claims 2 and 20 only, for neither Claims 2 nor 20 recite a "spring" while other of the claims such as Claims 4, 9, 11, 12 and 24 do.

Record 146a carries a statement by Mr. Morris which was accepted by Mr. Kraus, without comment, as follows:

> "Mr. Morriss: Claims 2 and 20, which are the broadest of the twenty-three claims in our application. *Bear in mind only two claims we consider to be in issue in this cause.*
>
> The Court: That is the claims with respect to the tension device?"

At page 152a Mr. Kraus, respondent's attorney affirmatively asserts that there are only two claims in issue as follows:

> "Mr. Kraus: *Now, the point I think I made, and I think your Honor has clearly understood it, is the two claims in issue call for resilient means for tensioning* (144) *the cable.* Now, what is that resilient means? It is nothing more than the cable itself. The wire itself when stretched becomes the resilient means."

At 185a this colloquy between counsel points up that there are only the two claims in issue:

> "Mr. Kraus: You are talking about Claim 25 now. It is not Claim 2 that you are examining the witness on?
>
> Mr. Morriss: Exactly. You will find it is related to the Claim 3. *This statement is made to clarify the position of both Claims 25 and 3, which ultimately issued as Claim 2 and Claim 20, which we have before us in issue today."*
>
> • • • • •
>
> "And, I think this is very pertinent, and I would like to point out to the Court that Claim 25 mentioned in this reading, your Honor, and Claim 3, ultimately issued *as Claims 2 and 20, the claims now in issue before us.*

> Mr. Kraus: *Will you agree that the entire statement that you read had reference to Claim 25 only, and Claim 25 is Claim 20, and that isn't the subject matter that he was being interrogated on? He was being interrogated on Claim 2. But, he has read now remarks made in reference to the other claim in issue."*

At page 231a Mr. Morriss makes the following statement without objection from Mr. Kraus:

> "Mr. Morriss: No; the only application, or *the only patent, your Honor, that is in issue, is United States Leters Patent 2,931,245, and Claims 2 and 20 thereof."*

At page 239a, Mr. Morriss again calls attention that claims 2 and 20 only are in issue and Mr. Kraus does not dispute the fact:

> "Mr. Morriss; There is another remark I would like to introduce in respect to this. *The matters in issue here are the questions of what claims 2 and 20 express;* not with regard to what the commercial —not with regard to a commercial embodiment comparison of these two."

The disclosure of the patent in suit was being discussed and, without objection from Mr. Kraus, Mr. Morriss at page 260a made this statement:

> "Mr. Morriss: —and I am not asking for a construction of the claim from the witness. I am asking for a simple question, do you see a statement in here that refers to a slidable pin under any circumstances, in Claims 2 and 20?"

Again at page 288a without any objection to the statement, Mr. Morriss asked the witness the following question:

"Q. Mr. Rice, *do you find as a consequence of looking at all of the art considered and before this Court, that the* (372) *principle involved in the Claims 2 and 20 of the patent in issue is shown by any of the prior art?*"

At pages 328a-330a, a positive agreement to limit the issues to claims 2 and 20 was made.

"Q. (By Mr. Morriss, continuing): I would like to turn to page 100 of the file history—no, *I am going to skip 100, because that deals with Claim 30, which is not at issue in this application.*

Mr. Rice, for the purposes of the Court, subsequently this application was allowed and the United States Letters Patent 2,931,245 issued containing the claims 2 and 20, as reviewed in this Court, so I think we can now depart from that phase of this examination.

Mr. Kraus: Before you do, I would like to read the page that was skipped, page 100 and this is what he says, the Jervis' attorney says about the Hunt patent:

'Hunt disclosure of multiple springs each spaced from the center of pivoting and each concentric with the control wire.'

What does that mean, sir?

Mr. Morriss: Max, read the whole thing there; I think you are leaving out the preamble part, which reads:

'For this purpose, Applicant has drafted (436) and herewith submits Claim 30.'

Mr. Kraus: *That is right, this is another claim.*

Mr. Morriss: *And he is now talking about different things than what we are talking about in Claims 2 and 20. I would point out to the Court that I would object to this inquiry from this point of view; other claims in the United States Letters*

Patent 2,931,245 deal with other features, not in issue before this Court in the two subdivisions.

The Court: *Do you agree with that?*

Mr. Kraus: *I agree,* except that this is a statement as to what the Hunt patent discloses, and Hunt doesn't change its disclosure from claim to claim. Whatever Hunt shows with respect to Claim 20 [30], is still the same disclosure.

The Court: Read that again.

Mr. Kraus: 'Hunt disclosure'—that is the Hunt patent discloses—'of multiple springs each spaced from the center of pivoting and each concentric with the control wire.'

The Court: I get it; go ahead.

Mr. Kraus: That is it. All I am trying to bring forth is that the Jervis' attorney recognized that the springs in Hunt were at the end of the cables, and away from the center point.

In other words, this (indicating) being the center (437) point (indicating), this is the pivot point, that the cables are connected to the mirror, and that the springs are around the cables away from the pivot point, and that is the distinction that was being made, and that is all I am trying to show.

Mr. Morriss: We do not quarrel with that, your Honor. What we do quarrel with is that—*I thought that Mr. Kraus is going to bring in something in connection with Claim 30, which is not in issue.*"

Petitioner submits that the above colloquy between the Court and Counsel for both parties is a complete agreement that claims 2 and 20 were the only claims being litigated. It should have the same status in limiting the issues to Claims 2 and 20 as did the stipulation in the *Popcorn case.*

Page 441a further indicates that claims 2 and 20 only were in issue by this quotation:

"Mr. Morriss: *Your Honor, I would like to object to the continual reference to the frictional aspects of this structure, when indeed we have made it quite clear that there are no frictional, independent frictional means in the Claims 2 and 20.*

The Court: I know, but he does not agree with you.

Mr. Kraus: Will your device work without friction?

The Court: This is not argument. You offered proofs, which point, as you say, to the fact that Mr. Kraus is talking about now is not covered by your Claims 2 or 20. Mr. Kraus disagrees with you. He is now presenting his point of view. What is wrong with that?

Mr. Morriss: Well, I think it is irrelevant in the sense that the real issue involved here are the elements of the claims. Now, there is no—

The Court: *I know, but the elements in the claims referred to tension devices, resiliency, and other things, that Mr. Kraus is now showing that these prior patents* (619) *equate with Claims 20 and 2. Hasn't he a right to do that?*

Mr. Morriss: Sure, he has a right to do it."

Page 463a clearly indicates that the claims involved were claims 2 and 20 only:

"Mr. Morriss:

Q. Are there other claims—listen to the question again—are there other claims in United States Letters Patent 2,931,245, in which additional elements are found which would, one, specifically locate springs; or, two, which would involve sliding pins; or, three, which would involve the specific resiliency found in the commercial embodiment?

Now I am speaking of the other claims not in issue before this Court.

A. And are such elements found in those other claims?

Q. In those other claims.

A. Yes, sir."

Thus it is seen that throughout the entire record counsel for both parties as well as the court considered claims 2 and 20 to be the only claims in issue.

In view of the above, this Court should grant this petition so that the judgment be limited to claims 2 and 20 only.

THE SECOND QUESTION INVOLVED

"2. Does the trial court's original opinion, filed in lieu of findings of fact and conclusions of law and specifically directed to claims 2 and 20 only, support a judgment holding all twenty-four claims of the patent 'invalid, void and lacking in invention over the prior art.'"?

Petitioner asserts that the trial court's original opinion, filed April 27th, 1964 dealt with claims 2 and 20 only and could not support a judgment holding all 24 claims invalid.

The Jacobson patent relates to a rear view mirror which is remotely controlled by a member either on the dashboard or the inside of the door. For the purpose of this petition a detailed description of the device is not necessary.

Claims 2 and 20 are quoted in the trial court's opinion (R 53a). These claims provide for the following broad elements:

(a) a control member and controlled member remote from one another each being mounted for movement about a pivot point;

(b) three cables having one set of ends secured to the controlled member at points spaced from each other and from the pivot point and the other set of ends secured to the control member in the same

manner, for pivotally supporting said members for movement about their respective pivot points, and

(c) resilient means for applying a force coincident with one of the pivot points so that the cables at all times and in all positions will be under substantially equal tension.

The trial court, when drafting its original opinion, realized that the parties, by acquiescence and agreement, had limited the issues to the validity of claims 2 and 20 only for after a few preliminary remarks, the court set forth its opinions as to each issue. The first point of the court's conclusions reads:

> "I. that *the patent claims here in suit* are invalid for want of novelty and inventiveness." (Emphasis supplied.) (See rear of Petition.)

Then a few lines later, the court said:

> "*The patent claims of Jacobson in issue* (see drawings) are as follows:" (Emphasis supplied.) (See rear of Petition.)

Immediately thereafter the court quoted claims 2 and 20 (R 53a). The court at the top of R 54a then stated what the novel features were in these words:

> "The alleged novel feature of the patented device is the tightening of the cables or wires by the use of coil springs so as to keep each in a state of equal tension. *These springs are referred to in the patent as "resilient means".* The maintenance of equal tension upon all cables, defendant asserts is novel because it renders the device completely 'stable'. A stable device lacks any tendency in

itself to move from the position in which it is placed".

The court used the word "patent' 'in the quotation, when it stated that "these springs are referred to in the patent as resilient means," but it used the word loosely, for "resilient means" is the expression used in claims 2 and 20 while in many of the other claims different language is used, including the word "springs".

The court later on discusses the several patents in the prior art. In this discussion, the court continually finds or does not find "resilient means" in these patents. He points out how each prior art patent does or does not have the three broad elements of claims 2 and 20 as set forth above. He does not discuss any of the other more limited elements found in the other twenty-two claims.

When discussing Chantraine, he sets forth the three broad elements of claims 2 and 20, and then says that Chantraine has no "resilient means." He discusses Hoffman to show an improvement over Chantraine.

He then discusses the British patent to Hunt and applies its disclosure to every element found in claim 2 (R 57a).

After some more discussion the court then stated: "• • • it must be concluded that the patent in suit is invalid for want of inventiveness" (R 59a).

Here again the court used the word "patent" loosely for as pointed out above he was considering claims 2 and 20 only in the opinion and had not in any manner whatsoever discussed the other more limited 22 claims, which include as elements the very details that make Petitioner's rear view mirror the success that it was and is.

As the judgment filed April 29th 1964 (R 63a) stated in its preamble that it was based on the court's opinion of

April 27th, it is obvious that the judgment, holding all of the claims of the patent invalid, is not supported by the findings in the opinion. Petitioner submits that this Honorable court should issue its writ of certiorari to correct this obvious departure from normal procedure, and return to petitioner the 22 claims which were not in issue.

THE THIRD QUESTION INVOLVED

"3. Does the trial court's opinion, altered twelve days after the judgment was entered, by removing page 2 from the filed opinion and inserting a new page therefor to make it superficially appear that the original opinion was directed to all of the patent claims, together with the trial court's supplemental opinion filed on February 12th, 1964, support the judgment holding all of the patent claims 'invalid void and lacking in invention over the prior art' when no additional findings of fact were made."?

After Petitioner's counsel requested the court to revise its opinion to make it consistent with the court's findings, as above discussed, the court removed page 2 from its filed opinion and substituted therefor a new page two. Where the original opinion stated:

> "I. that *the patent claims herein suit* are invalid * * *" (Rear of Petition)

the court altered it to read:

> "I. that *the patent here in suit* is invalid * * *." (R 52a)

Further along, where the original opinion stated:

> *"The patent claims of Jacobson in issue * * * are as follows:* (Rear of Petition)

the court altered this to read:

> *"The patent claims of Jacobson assertedly infringed * * * are as follows:* (R 52a)

Not a single finding of fact was changed in the original opinion, nor was any additional facts added. Petitioner therefore asserts that the two changes in the original opinion were superficial and did not change the basic fact that the opinion was dealing with claims 2 and 20 only and not with the entire patent. However the changes, though superficial, would lead a casual reader of the altered opinion to assume that the court's opinion had, at all times, been directed to all of the claims of the patent, even though the opinion is barren of any findings relating to any claims other than claims 2 and 20.

Even the Headnote editor of U.S.P.Q. was misled by these superficial changes. When the original opinion was reported in the advanced sheets, his last headnote read:

> "2,931,245, Jacobson, Remote Control Rear View Mirror, *claims 2 and 20 invalid and not infringed.*" (Rear of Petition.)

After the opinion was altered and when the permanent volume of USPQ was published the last headnote now read:

> "2,931,245, Jacobson, Remote Control Device, Particularly for an Automotive Rearview Mirror, invalid and not infringed" (141 USPQ 431).

This court needs no authority to support the elementary rule that the conclusions of law, as well as the judgment, must be supported by findings of fact. The courts below have failed to follow this elementary rule, and hence this petition.

On the same day that the court removed page two from its originally filed opinion and inserted the new page, it also filed its "Memorandum Supplementing Opinion filed on April 27th, 1964" (R 64a). This Memorandum is silent

concerning the alteration that the court had made in the original opinion. It does not include a single additional finding of fact. It simply calls attention to certain pages of the record, which the court states is evidence that all of the claims of the patent were being litigated.

When these references are considered, it is obvious that they do not support the court's "argument" in any manner whatsoever. During the trial, when the patent was being described or when the accused device was being differentiated from Petitioner's device or from the disclosure of the patent, certain details, which are found as elements in the other 22 claims were referred to and their functions discussed. It is this type of reference that the court refers to in its supplemental opinion as supporting his contention that all of the claims were litigated. Many of the record references cited by the court expressly refute its contention, for a reading of the reference pages in their entirety will show that insofar as validity is concerned, only claims 2 and 20 were involved.

As stated above, there is no prior art of any nature whatsoever that relates to any part of Jacobson's inventions except those broad elements as set forth in claims 2 and 20. It would thus appear that even though the trial court in its altered opinion and judgment found that all of the patent claims were invalid, there is nothing in the record, and certainly nothing in the opinions upon which these conclusions could be based. Petitioner therefore asserts that the 22 claims not in issue have been held invalid, not because the record shows that they are, but because the trial court mistakenly believed that he had to decide the validity of the entire patent in view of the pleadings (forgetting entirely about the agreement of the parties to limit the trial to the two claims only).

CONCLUSION

This case presents an ideal situation wherein this Honorable Court should exercise its power of supervision over the lower courts, because of their departure from the accepted and usual course of judicial proceedings. It is submitted that a writ of certiorari should be issued so that this Court may outline to the lower courts, what is the accepted and usual course of judicial proceeding which should be followed not only in the case at bar, but in all similar cases.

Respectfully submitted,

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